

Atty. Docket No. CH9-2000-0019US1
(590.082)

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 1-16 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1, 15, and 16 are independent claims; the remaining claims are dependent claims. The Examiner is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the foregoing amendments and following remarks.

Objection to Claim 16:

The Examiner has objected to claim 16 due to claim language that may raise a question as to the limiting effect of the language. Specifically, the Examiner is concerned with Applicants' use of the term "whereby" in the claim language. Applicants respectfully request that the Examiner withdraw the objection in view of the following comments.

Applicants have amended claim 16 to replace "whereby" with "wherein" and to add a comma to distinguish between limitation clauses in the claim. Applicants respectfully submit that the terminology of claim 16 is clear. Applicants note that the present amendment to claim 16 is made to address the Examiner's objection and not to

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overcome any cited prior art. Applicants intend no change in the scope of the claims by the changes made by this amendment and it should be noted these amendments are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution.

Rejection of claims 1-16 for Non-Statutory Double Patenting over Beitel:

Claims 1-16 stand rejected on the grounds of non-statutory double patenting over U.S. Patent 4,937,760 to Beitel et al (hereinafter Beitel). Specifically, the Examiner asserts that the current claims, if allowed, would improperly extend the "right to exclude" already granted by the Beitel patent. The Examiner further asserts that the claimed subject matter herein is fully disclosed by Beitel since the current application and Beitel claim common subject matter. The Examiner also asserts that there is no apparent reason why the current claims could not have been presented during prosecution of the Beitel patent.

Applicants previously addressed the current rejection in the Response dated March 7, 2006. Applicants respectfully submit that the remarks set forth therein are still applicable. Applicants, therefore, incorporate those remarks into this response. Furthermore, Applicants respectfully point out that the Examiner appears to be making a rejection for non-obviousness type non-statutory double patenting. The grounds for such a rejection come from the decision in *In re Schneller*, 158 USPQ 210 (CCPA 1968).

Applicants respectfully submit that application of the *Schneller* rule is limited to the **particular facts presented in that case**. And as such rejections based upon that rule

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will be rare. More specifically, only in circumstances where the facts of an application correspond exactly to the facts of the *Schneller* decision is such a rejection appropriate. Also, in order to make such a rejection the Examiner **must obtain permission from the Tech Center Director beforehand. MPEP § 804(II)(B)(2).**

In the current rejection the Examiner merely places emphasis (i.e., underlining) on certain portions of claims 1 and 2 of the Beitel patent and asserts that they correspond to elements of Applicants' claimed invention. The Examiner does not make any attempt to relate the facts of the current application to the facts of the *Schneller* decision. Nor does the Examiner explain, at all, exactly how the limitations of the current claims correspond to the claims set forth in the Beitel patent. Moreover, the Examiner has not indicated that permission from the TC Director was received before the Examiner made the current rejection. The rejection is therefore improper.

For the foregoing reasons Applicants respectfully request that the Examiner withdraw the rejection of claims 1-16 on the grounds of non-statutory double patenting over Beitel.

Rejection of claims 1-12 and 14-16 under 35 U.S.C. § 102(e) over Loveland:

Claims 1-12 and 14-16 stand rejected for being anticipated by U.S. Patent 6,782,413 to Loveland (hereinafter Loveland) under 35 U.S.C. § 103(a). Applicants respectfully submit that a claim is anticipated under § 102 only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art

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reference (MPEP § 2131). Applicants respectfully submit that the teaching in Loveland is not sufficient to anticipate independent claims 1, 15, and 16 under § 102.

Independent claims 1, 15, and 16 recite, in part, "setting up packet forwarding rules in said (computer) network(s) specifying a particular treatment for said returned packets dependent upon said predetermined response options." Applicants respectfully submit that Loveland does not disclose such subject matter.

As best understood, Loveland teaches a distributed conference bridge, which in one embodiment (Figures 5 & 6) provides call/message forwarding/handling features to a user. Specifically, the system allows a caller to choose a certain set of options when the desired party is not available to immediately respond to the caller's request based upon the capabilities of the caller's access terminal (i.e., PC, phone, etc.). (Figure 6 and Col. 18, lines 16-58)

Applicants respectfully submit that Loveland's teachings refer to formulating a response to a chosen option and are not concerned with the handling of the responses themselves. Even if one were to consider Loveland as teaching that response messages are returned over a network in one or more packets those packets are handled/forwarded by the system in the exact same way, no matter what predetermined response option is contained within the message packet. The network rules are established to determine how to respond to a caller's particular selection and not how to forward or treat a message packet in a particular way based upon the which of the predetermined response options is contained within the message packet. This is particularly evidenced by Figure 6, which

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does not indicate different handling/forwarding methodologies based upon what option is chosen (Figure 6, Col. 16, line 53 - Col. 17, line 11, and Col. 18, lines 16-58). The rejection is therefore improper.

Claims 1, 15, and 16 are allowable over Loveland for at least the foregoing reasons. Applicants respectfully request that the Examiner withdraw the rejections of claims 1, 15, and 16 for being anticipated by Loveland under 35 U.S.C. § 102(e).

Claims 2-12 and 14 are all dependent claims depending from independent claim 1 and as such are allowable over Loveland for at least the same reasons as claim 1. Applicants respectfully request that the Examiner also withdraw the rejections of these claims for being anticipated by Loveland under § 102(e).

Rejection of claim 13 under 35 U.S.C. § 103(a):

Claim 13 stands rejected as being unpatentable over Loveland in view of U.S. Patent 7,020,618 to Ward (hereinafter Ward) under 35 U.S.C. § 103(a).

With regards to this rejection, claim 13 is dependent upon independent claim 1. Applicants respectfully submit that claim 1 is allowable over Loveland as established above. Claim 13 is also allowable, then, for at least the same reasons as claim 1. Applicants respectfully request that the Examiner withdraw the rejection of claim 13 as being unpatentable over Loveland in view of Ward under 35 U.S.C. § 103(a).

In view of the foregoing, it is respectfully submitted that independent Claims 1, 15, and 16 fully distinguish over the applied art and are thus allowable. By virtue of

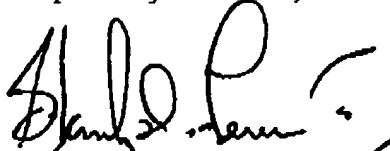
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dependence from Claim 1, it is thus also submitted that Claims 2-14 are also allowable at this juncture.

The "prior art made of record" has been reviewed. Applicants acknowledge that such prior art was not deemed by the Office to be sufficiently relevant to have been applied against the claims of the instant application. To the extent that the Office may apply such prior art against the claims in the future, Applicants will be fully prepared to respond thereto.

In summary, it is respectfully submitted that the instant application, including Claims 1-16, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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